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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,130	02/05/2002	Olga Bandman	PF-0319-2 DIV	2603

27904 7590 12/10/2003

INCYTE CORPORATION (formerly known as Incyte Genomics, Inc.)
3160 PORTER DRIVE
PALO ALTO, CA 94304

EXAMINER	
STEADMAN, DAVID J	
ART UNIT	**PAPER NUMBER**
1652	

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	10/072,130	BANDMAN ET AL.	
	Examiner	Art Unit	
	David J Steadman	1652	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ they raise the issue of new matter (see Note below);
   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
   NOTE: _____.
3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *see attachment*.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: *36-41*.

   Claim(s) rejected: *11,31,32,34,42 and 43*.

   Claim(s) withdrawn from consideration: *1,12,29,30,33,35,44 and 45*.
8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

ADVISORY ACTION

[1] Claims 1, 11-12, and 29-45 are pending in the application.

[2] Claims 1, 12, 29-30, 33, 35, and 44-45 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim.

[3] Claims 36-41 are objected to as being dependent upon a rejected base claim, but would appear to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

[4] Claims 11, 31-32, 34, and 42-43 are rejected.

[5] Applicant's amendment to the claims filed October 24, 2003 is acknowledged. This listing of the claims replaces all prior versions of the claims.

[6] Receipt of a corrected declaration in the amendment filed October 24, 2003 is acknowledged.

[7] The request for reconsideration is acknowledged, however the amendment does not place the application in condition for allowance for the reasons stated below.

[8] The written description rejection of claims 11, 31-32, 34, and 42-43 under 35 USC 112, first paragraph, is maintained for the reasons of record and the reasons stated below. The rejection was fully explained in previous Office actions. Applicants argue the amendment to claim 11 part b) to limit the genus of polypeptides to those having phosphatase activity overcomes the instant rejection. To the extent the rejection applies to part b) of claim 11, the rejection is withdrawn. However, the examiner maintains his position that the genus of claimed antibodies of claim 11 part a) is not

adequately described in the specification. The genus encompasses all species of antibodies that bind any protein "comprising" SEQ ID NO:1. It is noted that a polypeptide "comprising" SEQ ID NO:1 is not limited to the amino acid sequence of SEQ ID NO:1, but additionally includes any additional amino acid sequence at the N- and/or C-termini. As such, the genus of antibodies encompasses species that bind epitopes that are not present within the sequence of SEQ ID NO:1. Thus, the genus encompasses widely variant species. MPEP § 2163 states, "[f]or inventions in an unpredictable art, adequate written description of a genus which embraces widely variant species cannot be achieved by disclosing only one species within the genus". Therefore, the single disclosed representative species, i.e., an antibody that binds SEQ ID NO:1, is insufficient to describe the entire genus of claimed antibodies.

Applicants state the examiner indicated that the instant rejection would be overcome by amending claim 11 to recite the functional limitation of a having phosphatase activity (see page 8, top of the amendment filed October 24, 2003). However, it should be noted that only part b) of claim 11 was discussed. Thus, the examiner indicated that this functional limitation would appear to overcome the rejection only to the extent the rejection applied to part b) of claim 11.

[9] The scope of enablement rejection of claims 11, 31-32, 34, and 42-43 under 35 USC 112, first paragraph, is maintained for the reasons of record and the reasons stated below. The rejection was fully explained in previous Office actions. Applicants argue the amendment to claim 11 part b) to limit the genus of polypeptides to those having phosphatase activity overcomes the instant rejection. To the extent the rejection

applies to part b) of claim 11, the rejection is withdrawn. However, the examiner maintains his position that the scope of claimed antibodies of claim 11 part a) is not enabled by the instant specification. The broad scope of claimed antibodies encompasses all antibodies that bind any protein "comprising" SEQ ID NO:1. It is noted that a polypeptide "comprising" SEQ ID NO:1 is not limited to the amino acid sequence of SEQ ID NO:1, but additionally includes any additional amino acid sequence at the N- and/or C-termini. As such, the broad scope of claimed antibodies includes those antibodies that bind epitopes that are not present within the sequence of SEQ ID NO:1. The production of all antibodies encompassed by the broad scope of the claims would clearly require undue experimentation (see particularly the analysis of the Factors of *In re Wands* as set forth in the Office action mailed August 26, 2003).

Applicants state the examiner indicated that the instant rejection would be overcome by amending claim 11 to recite the functional limitation of a having phosphatase activity (see page 8, top of the amendment filed October 24, 2003). However, it should be noted that only part b) of claim 11 was discussed. Thus, the examiner indicated that this functional limitation would appear to overcome the rejection only to the extent the rejection applied to part b) of claim 11.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (703) 308-3934. The Examiner can normally be reached Monday-Friday from 7:00 am to 5:00 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX number for submission of official papers to Group 1600 is (703) 308-4242. Draft or informal FAX communications should be directed to (703) 746-5078. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman, Ph.D.
Patent Examiner
Art Unit 1652

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